

REMARKS/ARGUMENTS

Favorable consideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-4 and 6-8 are presently pending in this application, Claim 1 is canceled without prejudice or disclaimer, and Claim 1 is amended. No new matter is added.

In the outstanding Office Action, Claims 1-4, 6 and 8 were rejected under 35 U.S.C. §102(b) as being anticipated by JP 2002-348439 (hereinafter “JP ‘439”); Claims 5 and 7 were rejected under 35 U.S.C. §102(b) as being anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over JP ‘439; and Claims 1 and 3-8 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over JP 2001-247747 (hereinafter “JP ‘747”).

Regarding the rejection of Claims 1-8, Applicant respectfully submits that the rejection is overcome because, in Applicants’ view, amended independent Claim 1 patentably distinguishes over JP ‘439 and JP ‘747 as discussed below.

Claim 1 is amended to recite “the carbon precursor having a specific electric resistivity ... of $1 \times 10^4 \Omega\cdot\text{cm}$ or more but less than $1 \times 10^7 \Omega\cdot\text{cm}$,” which was recited in original Claim 5 and “[a]n epoxy resin composition ... not containing an organic coloring material.” The epoxy resin composition recited in Claim 1 exhibits excellent YAG laser marking properties even without an organic coloring material.

Regarding original Claim 5, of which the subject matter is now included in amended Claim 1, the outstanding Office Action asserts that although JP ‘439 and JP ‘747 do not explicitly disclose a resistivity range of $1 \times 10^4 \Omega\cdot\text{cm}$ or more but less than $1 \times 10^7 \Omega\cdot\text{cm}$, this would have been an inherent property because JP ‘439 and JP ‘747 satisfy all of the material limitations set forth in the instant invention (Office Action at page 3, paragraph 5 and at page 5, lines 14-16). Applicant respectfully disagrees with this assertion.

First, Applicant notes that carbon precursors may have various values of resistivity. For example, a carbon precursor described in JP '439 has an electric resistivity of $1.3 \times 10^{10} \Omega\cdot\text{cm}$ (JP '439 at paragraph (0013)), and carbon precursors described in the present application have electric resistivity of $1 \times 10^6 \Omega\cdot\text{cm}$ (Substitute Specification at page 10, Table 1, at page 14, line 19, at page 15, line 3), $1 \times 10^4 \Omega\cdot\text{cm}$ (Substitute Specification at page 14, line 5), $1 \times 10^6 \Omega\cdot\text{cm}$ (Substitute Specification at page 14, line 19), $1 \times 10^{10} \Omega\cdot\text{cm}$ (Substitute Specification at page 16, line 6), $1 \times 10^9 \Omega\cdot\text{cm}$ (Substitute Specification at page 16, line 16-17) and $1 \times 10^8 \Omega\cdot\text{cm}$ (Substitute Specification at page 16, line 27 though page 17, line 1). Thus, Applicant respectfully submits that the resistivity of the carbon precursor is not an inherent property.

JP '439 describes that a carbon precursor has an electric resistivity of $1.3 \times 10^{10} \Omega\cdot\text{cm}$ (JP '439 at paragraph (0013)). JP '439 further describes that the epoxy resin contains an organic coloring material (JP '439 at paragraph (0013)). Thus, JP '439 does not disclose that the carbon precursor has a specific electric resistivity of $1 \times 10^4 \Omega\cdot\text{cm}$ or more but less than $1 \times 10^7 \Omega\cdot\text{cm}$, and that the epoxy resin composition does not contain an organic coloring material.

Further, JP '747 does not describe that the epoxy resin composition contains a carbon precursor. It is noted that JP '747 describes that the epoxy resin composition contains a carbon black, but not a carbon precursor (JP '747 at paragraph (0013)). JP '747 further describes that the epoxy resin contains an organic coloring material (JP '747 at paragraph (0013)). Thus, JP '747 does not disclose that the carbon precursor has a specific electric resistivity of $1 \times 10^4 \Omega\cdot\text{cm}$ or more but less than $1 \times 10^7 \Omega\cdot\text{cm}$, and that the epoxy resin composition does not contain an organic coloring material.

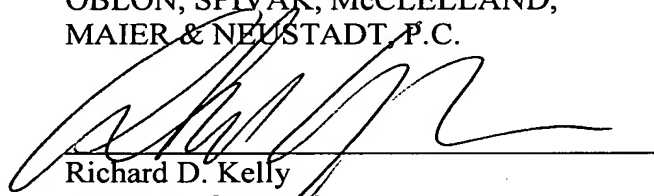
Thus, JP '439 and JP '747 fail to teach or suggest "the carbon precursor having a specific electric resistivity ... of $1 \times 10^4 \Omega\cdot\text{cm}$ or more but less than $1 \times 10^7 \Omega\cdot\text{cm}$ " and "[a]n epoxy resin composition ... not containing an organic coloring material," as recited in Claim 1.

Accordingly, independent Claim 1 patentably distinguishes over JP '439 and JP '747. Therefore, Claim 1 and the pending Claims 2-4 and 6-8 dependent from Claim 1 are believed to be allowable.

In view of the amendments and discussions presented above, Applicant respectfully submits that the present application is in condition for allowance, and an early action favorable to that effect is earnestly solicited.

Respectfully submitted,

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